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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,316	01/18/2002	Alfred Thomas	2100/17	8018

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EXAMINER	
MOSSER, ROBERT E	
ART UNIT	PAPER NUMBER
3712	

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/051,316	THOMAS ET AL.	
	Examiner	Art Unit	
	Robert Mosser	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *March 1st, 2005*.

2a)☒ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-47,49-80,82-103,112-114 and 116-127* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *112 and 113* is/are allowed.

6)☒ Claim(s) *1,3-47,49-80,82-103,114 and 116-127* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

♦

Responsive to the RCE filed April 26th, 2006.

This action is Non-Final.

Claims 1, 3-47, 49-80, 82-103, 112-114, and 116-127 are pending.

♦

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 26th, 2006 has been entered.

Official Notice

In the office action dated November 1st, 2005 the following Official Notice statements were made and not traversed in the subsequent response by Applicant, accordingly the following statements are considered Applicant Admitted Prior Art.

On page 5 of the afore mentioned office action the Examiner gave Official Notice that it is well known in the art to employ player tracking systems as a means of tracking players and awarding valuable players {those that frequent the gaming establishment

and/or spend large sums of money on the gaming machines}. This Feature is now considered to be applicant admitted prior art.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **13**, **23-35**, **56**, and **89**, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims **13, 23, 56,** and **89,** set forth a dependent relationship between the outcome of the first and the outcome of the second game through the following exemplary language.

> "...each opening prize indicia being selected as well as discarded in accordance with it's associated card, said card game including the further step of replacing any discarded card with another randomly selected card and said second game of chance including the step of replacing any discarded prize indicia with another randomly selected prize indicia." (Claim 13)

In short claim **13** defines a relationship wherein responsive to a user's interaction with the elements of a first game, the elements of a second game are altered. Accordingly a user's interaction with a first game, such as selecting a game element to discard result in the replacement of the respective element in both a first game and the second game. As the game outcome for both the first and second game are determined by the final composition of the respective game elements, the user's interaction with the first game results altering the outcome of the first game and the

second game. This is in direct contradiction to the exemplary independent claim **1** from which claim **13** depends. Exemplary claim **1** as presented defines the game outcomes of the first and second game as being "unrelated" and "irrespective" of one another. It is unclear how game outcomes can be both unrelated and at the same time both contain a result determined by the same user interaction.

As claims **13, 23, 56**, and **89**, set forth an relationship between elements that is contradictory to the relationship between the elements established in their respective independent claims these claims are deemed indefinite for failing to clearly set forth the metes and bounds of the claimed invention in a manner that would be clear to one of ordinary skill in the art of claimed invention.

Claims **24-35** fall for their dependency on independent claim **23** addressed above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1, 3-12, 14-21, 36-39, 41, 43-47, 49-55, 57-80, 82-88, 90-103, 114,** and **116-127** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullins (US 5,158,293) in view of Marnell II et al (US 5,332,219) in yet further view of Nelson et al (US 6,749,500).

Claims **1, 11, 41, 47, 64, 78, 96, 98, 103, 114**: Mullins teaches a game including:

A second or Instant game of chance on the same game device that has a second set of positions different from said first set of positions for a second set of game elements different from said first set of game elements (*Mullins* Elm 120, 11 & Fig 3) and wherein the second game further includes the potential for awarding only a non-monetary prize outcome for every play thereof (*Mullins* Col 3:30-40);

Placing a wager through a wager registering mechanism (*Mullins* Col 2:27-28 & *Marnell* Col 4:43-47);

Operating said second game of chance in conjunction with said first game of chance and in a manner unrelated to any outcome in the first game of chance (*Mullins* Col 2:34-37, 3:30-33, & 4:1-8);

Awarding any prize achieved in said second game of chance irrespective of any outcome in said first game of chance (*Mullins* Col 3:30-33 & Col 4:1-8).

Mullins however is silent regarding the incorporation of a lottery device into a game machine however Marnell teaches the incorporation of a lotto game into a gaming machine as being known in the art of gaming (*Marnell* Col 1:13-25). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the lotto game of Mullins onto an electronic gaming device as taught by Marnell in order to utilize a game delivery platform that would automate lotto sales/redemption and/or to avoid the generation of paper waste and distribution costs associated with the utilization of paper tickets.

The combination of Mullins/Marnell teaches the inclusion of playing cards for simulating card games including poker and blackjack (Mullins Col 3:7-9), however is arguably silent regarding a specific teaching for the inclusion of a card game as the first game of Mullins/Marnell. In a related lottery teaching Nelson teaches the representation of a lottery game as a five card poker game including allowing the player to select which cards to hold and/or discard (Nelson Col 2:6-12). It would have been obvious to one of ordinary skill in the art at the time of invention to have supplemented the lottery game of Mullins/Marnell with an instant type lottery game representing a five card poker game as taught by Nelson in order to offer the game players and additional lottery game (Mullins Col 2:33-37) as well as a more interesting lottery game (Nelson Col 1:61-64).

Operating a first game of chance including a first set of positions for a first set of game elements and concluding said first game in a monetary outcome/award (*Nelson Col 4:24-32, Col 6:40-48, Col 7:24-43, Col 8:2-5*);

Claims **3-5, 15-19, 37-39, 58-61, 65-71, 73-76, 91-94**: The combination of Mullins/Marnell/Nelson as taught above teaches the awarding of non-monetary prizes (*Mullins* Col 3:38-40 & 4:7-8 & Nelson Col 6:40-48) however is silent regarding the specific inclusion of non-monetary prizes of tangible goods, services, and/or registered point values however, it would have been obvious to one of ordinary skill in the art at the time of invention to have utilized non-monetary prizes including non-monetary prizes of tangible goods, services, and/or registered point values as the non-monetary prizes of Mullins/Marnell/Nelson as one of ordinary skill in the art at the time of invention would have recognized the non-monetary prizes of tangible goods, services, and/or registered point values as equivalents to any other non-monetary prize which the players deem valuable (Mullins Col 3:38-40). Alternatively, it would have been obvious to one of ordinary skill in the art at the time of invention to have utilized non-monetary prizes including non-monetary prizes of tangible goods, services, and/or registered point values as the non-monetary prizes of Mullins/Marnell/Nelson in order to provide the respective players with the prizes desired by the respective players.

Claims **6, 12, 49, 55, 82, 88**: The combination of Mullins/Marnell/nelson as taught above teaches the operating the second game of chance only once at the beginning of the first game of chance (*Mullins* Col 2:40-50 & Fig 2,3) wherein both games are understood to commence with the distribution of the lottery ticket/game to the player.

Claims **7, 9, 50, 52, 54, 83, 85-87**: The combination of Mullins/Marnell/Nelson as taught above teaches the inclusion of multiple prize indicia (*Mullins* "L","O","T" as shown in Elm 23, and figures 2-3 & Col 2:63-3:9), with a preset number of prize indicia being displayed to the player in the course of the second game (Equated to the 5 prize indicia per row in the instant game of *Mullins* figures 2-3) as randomly selected (*Mullins* Col 5:14-17), and a final prize awarded to the player based on a predetermined association of the prize indicia including matching (*Mullins* Col 2:66-3:9 *'3 bells'*).

Claims **8, 51, 72, 84**: The combination of Mullins/Marnell/Nelson as taught above teaches a plurality of different prize awards (*Mullins Elm 121 line numbers 1,4,8 with respective payouts of $10, $1, and $100*).

Claim **10, 53**: The combination of Mullins/Marnell/Nelson teaches the inclusion of the same number of game elements of five in a first lottery based card game (Nelson Col 4:33-39) and in a second game (Mullins Elm 121). Wherein the cards are dealt/presented to the player in the first game (Nelson Col 2:6-15).

Claim **14, 36, 57, 90, 99 116-127**: The combination of Mullins/Marnell/Nelson teaches the use of a video display for displaying the outcome of a poker game as taught below in at least the rejection of claim 79; however Mullins/Marnell/Nelson is silent regarding the particular use mechanical or video reels for displaying the result of a poker game.

The examiner gives Official Notice that the utilization of a plurality of mechanical and video reels display directly related to the number of game elements being displayed is exceptionally old and well known in the art of gaming for displaying the results of card games including poker. It would have been obvious to one of ordinary skill in the art at the time of invention to have utilized mechanical or video slot reels as the poker game result display in the game of Mullins/Marnell/Nelson in order to utilize a display technology best suited to the target player age group or alternative utilize a display technology better suited to the desired operational environment of the device.

Claim **20, 62, 77, 95, 102:** The combination of Mullins/Marnell/Nelson teaches awarding of a bonus game as a prize to the second game (Mullins Elm 23) wherein upon a bonus qualifying outcome (Mullins Elm 22) in the second game the player receives the ability to participate in a bonus/third game (Mullins Col 4:34-38).

Claims **21, 43, 63**: The combination of Mullins/Marnell/Nelson teach all the limitations of the claims as discussed above, however the presented combinations are silent regarding the incorporation of a player tracking system and the limiting of game play based thereon. The incorporation of a player tracking system and rewarding of players depending on their interaction is held as Applicant admitted prior art (See note above under 'Applicant Admitted Prior Art'). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include player tracking the

combination of Mullins/Marnell/Nelson as an incentive for a player to participate in the player tracking system to receive free game plays.

Claims **44-46**, The combination of Mullins/Marnell/Nelson teach the utilization of tickets vouchers and any form of winnable unit that may be used in a game device (Nelson Col 6:40-48) however is silent regarding the specific inclusion of printers for producing these tickets or vouchers. The Examiner gives Official Notice that it is well known in gaming arts to incorporate printers for printing out tickets or vouchers that a player may redeem at a cashier's station or other place within the gaming establishment. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the feature of a printer in the combination of Mullins/Marnell/Nelson to provide an easy, convenient means for players to receive game credits and to lessen the amount of currency handling within a casino.

Claims **79, 80, 97**: The combination of Mullins/Marnell/Nelson teach the system and method as presented above including a video display (Marnell Col 4:16-18), a CPU (microprocessor) for controlling the game apparatus (Marnell Col 4:53-55), a wager input mechanism (Marnell Col 4:43-46), a random number generator (Marnell Col 5:44-48), and a stored pay-table imbedded in memory (Marnell Col 5:1-15).

Claim **100**: The combination of Mullins/Marnell/Nelson teaches the system and method as presented above including the use of a wild card (Marnell Col 1:44-56).

Claim **101**: The combination of Mullins/Marnell/Nelson teach the system and method as presented above including the use cards however is silent regarding the specific use of Joker cards. The Examiner gives Official Notice that the use of Joker cards is old and well known in the art of gaming. It would have been obvious to one of ordinary skill in the art at the time of invention to have utilize Joker cards as the wild cards of Mullins/Marnell/Nelson set forth above in the rejection of claim 100, in order to provide a wild card symbol that would not be easily confused with the remainder of the cards in a standard card deck.

Claims **22, 40, 42** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullins (US 5,158,293) in view of Marnell II et al (US 5,332,219) in further view of Nelson et al (US 6,749,500) in yet further view of Meekins et al (US 6,685,563).

The combination of Mullins/Marnell/Nelson teach the system and method as presented above however is silent regarding the requirement of a wager amount or threshold in order to qualify for a secondary game however, in a related art related invention Meekins teaches the inclusion of this feature in a lottery device (Col 3:52-67; 5:10-18; 6:14-26).

Allowable Subject Matter

Claims **112-113** are allowed.

Claims **13, 23-35, 56,** and **89** were previously objected to due to dependency on rejected claims. These claims are now subject to rejected under USC 112 as presented above.

Reasons for the indication of allowable subject matter can be found in the previous office action (paper #9, 12/3/03), which is incorporated herein by reference.

Response to Arguments

Applicant's arguments with respect to claims **1, 3-47, 49-80, 82-103, 112-114,** and **116-127** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5393057 – Marnell teaches an electronic gaming device.

US 5569082 – Kaye teaches a personal computer lottery game.

US 6857959 – Nguyen teaches a name your prize game playing methodology.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MARK SAGER
PRIMARY EXAMINER

REM